

REMARKS

Reconsideration of the present application is respectfully requested. Claims 19-39 have been canceled in this amendment. Claims 40-71 are newly added. No new matter has been added. Claims 40-71 are now pending.

Claims 19-26 (canceled) were rejected under 35 U.S.C. § 102(e) based on U.S. Patent no. 5,822,539 of Van Hoff ("Van Hoff"). Claims 27-29 and 37-39 (canceled) were rejected under 35 U.S.C. § 102(e) based on U.S. Patent no. 6,209,036 of Aldred et al. ("Aldred"). Claims 30-36 (canceled) stand rejected under 35 U.S.C. § 103(a) based on Van Hoff in view of U.S. Patent no. 5,897,638 of Lasser et al. ("Lasser").

Before discussing the claims, a brief overview of the invention may be helpful. The present invention facilitates the use of frequently used hyperlinks (referred to as "favorites" or "bookmarks") by a wireless client device with limited internal memory, such as a mobile telephone, PDA, etc. As noted in the specification (p. 3, lines 16-20), one of the problems with the prior art is that the available memory in such client devices is generally insufficient to store a set of "favorites" or "bookmarks". The present invention overcomes this problem in certain embodiments by storing in a remote server a set of bookmarks/favorites associated with a particular wireless client device. The set of bookmarks/favorites are accessible to the wireless client device for purposes of requesting network resources (e.g., web pages, etc.) and can be updated from the wireless client device, all via a wireless network.

Independent claims 40 and 56 generally relate to a process of updating a set of resource locators (e.g., bookmarks/favorites) stored in a server. Independent claims 48

and 64 generally relate to a process of accessing a network resource using a set of resource locators (e.g., bookmarks/favorites) stored in a server.

For example, claim 40 recites:

40. (New) A method comprising:
receiving at a wireless client device a network resource over a wireless network;
receiving at the wireless client device a user input applied at a user interface of the wireless client device;
generating a request at the wireless client device in response to the user input, the request including an identifier of the network resource; and
sending the request to a remote server via the wireless network to cause a set of resource locators stored in the remote server and **associated with the wireless client device** to be updated based on the request, **the set of stored resource locators being accessible to the wireless client device via the wireless network to enable a user of the wireless client device to select any of the stored resource locators to generate a request for a corresponding network resource.**
(Emphasis added.)

The cited references do not disclose or suggest such a method, either individually or in combination. Van Hoff discloses a technique for automatically annotating a received document with hypertext links to supplemental information related to the topic of the received document. Col. 2, lines 7-10. In particular, Van Hoff discloses an annotation directory 191, 192 stored in a proxy server 118, 119. The annotation directory 191, 192 stores multiple paired entries, where each paired entry includes a cross-reference document source field 194 (a hypertext link) and a match pattern field 195. Fig. 2; col. 7, lines 12-23. Each cross-reference source field 194 identifies the unique location of a cross-reference document, and each match pattern field 195 defines a character pattern (symbols, words, etc.). If the character pattern is

found in the document being considered, an associated hypertext link (cross-reference) is inserted into the document. See also Fig. 3.

However, in contrast with claim 40, Van Hoff does not disclose or suggest storing in a remote server a set of resource locators associated with the client device and accessible to the client device to enable a user of the client device to select any of the stored resource locators to generate a request for a corresponding network resource.

First, in Van Hoff the user cannot select "any" (as recited in claim 40) of the resources locators stored in the server (such as source fields 194 in the annotation directory 191, 192) to request a network resource. The user in Van Hoff can select only those hypertext links which have been added to a document as a cross-reference through the annotation process. Second, in Van Hoff the hypertext links (source fields 194) stored in the annotation directory 191, 192 are not associated with any particular client device, in contrast with claim 40. For at least these reasons, therefore, claim 40 is not anticipated by Van Hoff.

In addition, Van Hoff does not disclose or suggest that the client device may be a wireless client device which accesses the set of stored resource locators via a wireless network. The examiner addressed this claim limitation on page 3 of the Office action (regarding claims 22-24) by contending this limitation is "inherent" in Van Hoff. The examiner's contention is in error. "Inherency . . . may not be established by mere probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. At 1269 (quoting In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (emphasis added)). There is absolutely no

suggestion in Van Hoff that a client device may be a wireless device. For this additional reason, therefore, claim 40 is not anticipated by Van Hoff.

Furthermore, the present invention would not be obvious based on Van Hoff, as discussed below (following the discussion of Aldred).

Claim 40 also is not anticipated by Aldred. Notwithstanding the following remarks, Applicant reserves the right to swear behind Aldred in a subsequent response to Office Action, if necessary. Applicant notes that the filing date of Aldred is June 6, 1997. The present application is a continuation of an application filed on December 22, 1997, which claims the benefit of the provisional application filed on July 11, 1997.

Aldred (unlike Van Hoff) does disclose the use of bookmarks. Aldred is directed to solving certain problems related to using URLs on the World Wide Web, although not to the problem solved by the present invention. Aldred purports to solve these problems by creating an LDAP directory in a directory server to store URLs of web pages. Other web pages may include directory-reference URLs that reference objects ("PPOs") in the directory. When a user selects a hyperlink including a directory-reference URL in a web page, logic in the client system automatically accesses the directory and retrieves the referenced web page. Col. 3, lines 61-65; col. 4, lines 3-4, 29-31, 45-47.

However, like Van Hoff and in contrast with claim 40, Aldred does not disclose or suggest storing in a remote server a set of resource locators associated with the client device and accessible to the client device to enable a user of the client device to select any of the stored resource locators to generate a request for a corresponding network resource.

In particular, Aldred does not disclose or suggest storing bookmarks in a server. Aldred only discloses storing bookmarks in the client. See col. 7, lines 4-5; col. 9, line 66 to col. 10, line 1. Even in the so-called "server side" implementation of Aldred (Figs. 4 and 5), the bookmarks are still stored in the client. See col. 11, lines 7-8. Furthermore, the mere fact that Aldred discloses a client/server architecture cannot render it obvious to store bookmarks in a server, as done by the present invention, because Aldred has nothing to do with the problem solved by the present invention (enabling a wireless client device with limited internal memory to use bookmarks/favorites).

If the examiner considers the URLs stored in the directory server to represent the "set of resource locators" of claim 40, then there are at least three reasons why claim 40 still is not anticipated by Aldred. First, the URLs stored in the directory server are not associated with any particular client, in contrast with claim 40. Second, Aldred does not disclose or suggest that the URLs in the directory can be updated from a client device, in contrast with claim 40.

Third, the user in Aldred does not select a URL in the directory server to request a network resource, in contrast with claim 40. The user selects a directory-reference URL in a document that has been downloaded to the client. That directory-reference URL merely references an object ("PPO") in the directory which contains a list of URLs; this list is then sent back to the client. The client machine then automatically selects a URL from the list at random and attempts to access the referenced web page. Col. 10, line 36-38 and 43-47; col. 9, lines 33-46. Thus, the user does not select a URL in the directory server to request a network resource.

Moreover, Aldred provides no suggestion that the client device may be a wireless client device which accesses the set of stored resource locators via a wireless network. The examiner's contention that this is "inherent" in the cited art (p. 5 of Office Action) is in error for the reasons noted above (see above remarks regarding Van Hoff).

For these reasons, therefore, claim 40 is not anticipated by Aldred.

In addition, the present invention would not be obvious based on the cited references, either individually or in combination. To establish a prima facie case of obviousness, among other requirements there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings. "[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). In addition, the claimed subject matter as a whole must be shown to be obvious. 35 U.S.C. § 103(a).

Neither Van Hoff nor Aldred even hints at the problem solved by the present invention, i.e., enabling a wireless client device with limited internal memory to use bookmarks/favorites. Hence, there can be no motivation or suggestion found in either reference to modify their teachings to achieve the claimed invention. Moreover, the claimed invention as a whole would not be obvious based on the cited art.

The remaining independent claims include limitations similar to those in claim 40 discussed above. Therefore, all pending claims are patentably distinguishable from the cited art and should be allowed.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Applicant notes, however, that some of the new dependent claims recite subject matter that was not previously claimed explicitly. All of the new claims are supported by the original description, however; no new matter has been added.

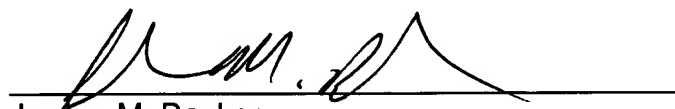
For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,
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12/17/03


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